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SUPREME COURT OF THE UNITED STATES

October Term, 1999

No. [redacted] 51

HERBERT L. HILDRETH, Petitioner,

vs.

JIM M. MASTORAS, Respondent.

PETITION FOR CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1919.

No. 921

HERBERT L. HILDRETH, PETITIONER,

vs.

JIM M. MASTORAS, RESPONDENT.

PETITION FOR CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

To the Honorable the Supreme Court of the United States:

Petitioner, Herbert L. Hildreth, respectfully represents that he is aggrieved by a final decree of the United States Circuit Court of Appeals for the Ninth Circuit passed and enrolled in a certain cause therein pending wherein Jim M. Mastoras is appellant and your petitioner, Herbert L. Hildreth, is appellee, said cause being numbered 3341 on the docket of said circuit court of appeals, the decree here complained of having been passed

in said cause on the 24th day of February, 1920 (R., 342), but by reason of the filing and pendency of a petition for rehearing which was denied on the fifth day of April, 1920 (R., 343), only became final on the latter date.

To review said final decree upon the grounds and for the reasons hereinafter set forth at large, and to revise and set aside the same if it be found to be erroneous, or in opposition to the final decrees of other circuit courts of appeals sitting in other judicial circuits, as it is believed and averred to be, your petitioner respectfully prays the issuance out of this honorable court of its writ of certiorari, as provided in and by sections 139 and 240 of the Judicial Code as amended by the act of September 6, 1916 (39 Stats., 726).

STATEMENT OF CASE AND REASONS WHY PETITION SHOULD BE GRANTED.

This action was brought in the District Court of the United States in and for the District of Oregon by petitioner, Herbert L. Hildreth, a resident of Boston, in the Commonwealth of Massachusetts, against the respondent, Jim M. Mastoras, a resident of Portland, in the State of Oregon, to enjoin the infringement of letters patent No. 831,501 (R., 222), for candy-pulling machines, issued on the 18th day of September, 1906, to petitioner, as assignee of the inventor, Herbert M. Dickinson.

Respondent Mastoras denied the validity of the patent and infringement, basing his defense in part on the supposed protection afforded to him as assignee of letters patent No. 1,232,697, issued to G. L. Langer, July 10, 1917 (R., 297).

The issues thus raised were tried before the Honorable Charles E. Wolverton, district judge, who, in an elaborate opinion (R., 18), held claim 1 of the patent in suit (to Hildreth, assignee of Dickinson, No. 831,501) to be valid and to have been infringed by the respondent Mastoras, and directed issuance of injunction and the reference of the case to a master for accounting.

On appeal by Mastoras to the Circuit Court of Appeals for the Ninth Circuit, that court held that Dickinson was not the pioneer inventor of a candy-pulling machine in view of the earlier patent to P. J. Firehau, No. 511,011, issued December 19, 1893 (R., 269); that the machine of the Dickinson patent in suit was inoperative to pull candy commercially; not being susceptible of use commercially, it was without utility, and being without utility it would not support an action for infringement as against a commercially useful machine, the learned circuit court of appeals, in this connection, saying (R., 336):

> "* * * Dickinson was not the first to invent a machine to pull candy. But if he were the first, as the appellee contends, he acquired no more than the exclusive right to

pull candy in the way which he specified (in his letters patent) and he is not justified in claiming the exclusive right to pull it in some different way.

"The testimony leaves it doubtful whether the Dickinson machine is operative. * * * (R., 337.) The fact that under a patent no machine has ever been made and shown to work successfully does not prevent the owner of the patent from restraining infringement. *Bement vs. National Harrow Co.*, 186 U. S., 70, 90. But it is also true that if the patented device is not operative, it cannot be infringed by one that is. *Roger vs. Coupe*, 29 Fed., 358; * * * and other cases cited."

(R., 338:) "The case at bar is not one of those in which the first embodiment of a generic invention works imperfectly, but (and) in which the defects may be remedied by readjustment or relative changes in size or shape or construction of members. It is not a case in which the invention as described is crude or defective, but is susceptible of improvement. *If there is inoperativeness here, it is inherent in the very conception and structure of the device. If it is not susceptible of use commercially, it has no utility, for it is obvious that such a machine can have no utility except in the commercial field.**

"But aside from the question of the operativeness and utility of the Dickinson machine, we are of opinion that the decree

* All italics supplied.

should be reversed for the failure of the appellee to sustain the charge of infringement. *It is unnecessary to follow the appellee* (petioner here) *into the field of his prior litigation in suits in court, or in interference proceedings in which the Dickinson application and several other applications for patents, including an application of the appellee, were involved, resulting in the award of priority to the Dickinson.** In the determination of the question of infringement involved in the present case, the appellee must stand upon the Dickinson patent. *It is a legal presumption that a later patent does not infringe an earlier patent.** *Putnam vs. Keystone Bottle Co.*, 38 Fed., 234;" and numerous cases cited. "Prior to (R., 339) the use of machines candy was pulled by hand with the aid of a single hook. To pull it successfully by machinery two or more hooks are necessary. Dickinson used three and Langer uses three. But the principle and mode of operation of the two machines are different. One of the elements of claim 1 of the Dickinson patent is 'means for producing a specified in-and-out motion of these parts for the purpose set forth.' Of course, a specified movement of a machine irrespective of the mechanism which causes it is not patentable. The patent laws give protection to the inventor of a 'new and useful art, machine, manufacture, or composition of matter.' Here the subject of the patent is a machine, and it creates a monop-

* All italics supplied.

> oly in the use and sale of the machine only. It does not and cannot cover a mode of operation. * * * Comparing the Dickinson machine with that of Langer, with reference to claim 1 of the former, we find that Langer's machine has a 'plurality of oppositely-disposed candy hooks' which are also supports, and that the Dickinson machine has a plurality of 'oppositely-disposed candy hooks' which are hooks only and not supports. *Both machines have means for producing a relative in-and-out motion of hooks.** Dickinson's claim for a 'specified' relative in-and-out motion must be held to mean the in-and-out motion which is specified in the claims and specifications and exhibited by the machine itself. Dickinson acquired no monopoly of all in-and-out motions in candy-pulling machines. * * *"

As the result of such reasoning and conclusion, the decree of the District Court of the United States for the District of Oregon holding claim 1 of the Dickinson patent in suit to be valid and to have been infringed by respondent was reversed and the cause remanded to the district court with direction to dismiss the bill.

This decree of the Circuit Court of Appeals for the Ninth Circuit and the entire reasoning of the opinion upon which said decree is based is directly opposed to the decree of the District Court of the

* All italics supplied.

United States for the District of Maryland (Rose, D. J.), in the case of *Hildreth vs. The Lauer & Suter Company*, 208 Fed. R., 1005 (reproduced in Record, p. 167), which was affirmed on appeal by the Circuit Court of Appeals for the Fourth Circuit (Woods, Cir. J.), 219 Fed., 753. See Record, page 18.

It is also opposed to the unanimous line of decisions in the United States Patent Office in the interference proceedings in which Dickinson's application was involved, that is:

1. To the decision of the Examiner of Interferences, dated May 25, 1904 (R., 124), which was affirmed on appeal,

2. By the Board of Examiners-in-Chief, July 27, 1904 (R., 153); further affirmed,

3. By the Commissioner of Patents, December 6, 1904 (R., 156); and on appeal from said decision of the Commissioner of Patents finally affirmed,

4. By the Court of Appeals of the District of Columbia, 25 App. D. C., 316 (R., 163).

In each of these several successive decisions, Dickinson was awarded priority of invention, and all questions as to the operativeness of the Dickinson machine and as to its pioneer or basic position in the art were decided in his favor.

The Court of Appeals of the District of Columbia, per Morris, A. J., said in such connection:

> "Upon the testimony adduced in the case all the tribunals of the Patent Office concurred in awarding judgment of priority of invention to Dickinson; and Jenner and Thibodeau have appealed to this court.
>
> "We find no sufficient reason to question the correctness of the conclusions reached by the tribunals of the Patent Office in these interferences. We think those conclusions were fully warranted by the evidence. Taking it as the pivotal point in the controversy that Dickinson reduced the invention to practice by the construction of an operative machine, if it was operative, on or about January 29, 1900, and that he applied for a patent for the invention within two years thereafter, on November 5, 1901, we find that Thibodeau confessedly did not conceive the invention, as embodied in the machine constructed by him, until May 10, 1900, at least three months afterwards and then only after seeing one of Dickinson's machines. So there is no reasonable ground for controversy between Dickinson and Thibodeau other than the question of the operativeness of Dickinson's machine. But this operativeness has been amply proved. Undoubtedly Dickinson's machine is not the best of those that have been offered in evidence in this case; Thibodeau's is probably an improvement on it; but it embodies the principle of the invention, and it has been successfully operated. To that effect is the great preponderance of the evidence."

The prior art of the Firehau patent, No. 511,011, on which the ninth circuit largely based its opinion, was fully considered in connection with the Dickinson application by the Patent Office, having been cited as a reference against original claims numbered 1 and 2 thereof (see Dickinson file-wrapper and contents, Record, p. 213), which claims were abandoned, but original claim 3, which is now claim 1, was not involved in the citation and was allowed in the form in which tendered, because understood and ruled by the Patent Office examiners, experts in all such matters, to be entirely independent of and not affected by any claim of the Firehau patent. Identically the same contentions as to invalidity of the patent in suit (Hildreth, assignee of Dickinson, letters patent 831,501) because of inoperativeness of the Dickinson machine shown were urged by defendant, The Lauer & Suter Company, in Hildreth *vs.* The Lauer & Suter Company (United States District Court for the District of Maryland) and same were broadly resolved in favor of your petitioner, the learned District Judge Rose saying (R., 167, 178):

> "The defendant contends that the Dickinson patent is invalid because it is for an inoperative device. In the interference proceedings the same contention was made by the present plaintiff (petitioner here). Every one of the Patent Office boards and officials before which the interference came decided that it (said contention as to in-

operativeness) was not well founded. Th
Court of Appeals of the District of Colum
bia agreed with them. The thorough inve
tigation which Dickinson's application the
received as a result of that long-drawn-ou
contest in which this very issue was repea
edly raised, adds unusual weight to the ord
nary presumption of validity which attache
to every patent. In this connection also
is necessary to keep in mind for what inve
tion this claim was granted. As alread
pointed out, the great thing which Dickin
son found out was that oppositely dispose
candy hooks and a candy-puller given
specified in-and-out motion would mov
candy along a figure 8 pathway and woul
thereby pull it. *That conception instead*
being inoperative, is in operation in eve
one of the hundreds of candy-pulling ma
chines now in use. It is operating today
pull almost all the candy which is pulled
these United States.

He (Dickinson) complied with the r
quirements of the law by devising a machin
which would give this in-and-out motion
the hooks and puller and would move th
candy along the designated road. It is tru
that it is highly doubtful whether with h
machine candy could be pulled for com
mercial purposes. The form of telepho
which Bell made was valueless for practic
use. Dickinson was able to see what had f
years been hidden from all others. His di
covery was illuminating. His executio
poor. In patent cases it has been oft
noted that persons of the most brilliant co

ceptions are sometimes the poorest mechanics.

"In view of the action of the Patent Office and of the Court of Appeals of the District of Columbia, of the facts disclosed by this record, and of the principles laid down in many well-considered and authoritative decisions, the defense of inoperativeness cannot be sustained.

Telephone case, 126 U. S., 535.
Crown Cork & Seal Co. *vs.* Aluminum Stopper Co., 108 Fed., 845.
Van Schmidt *vs.* Bowers, 80 Fed., 149.
Packard *vs.* Lacing Stud Co., 70 Fed., 67.

"Defendant says, however, that if so much be held against it, still this claim must be stricken down, because it is so broad that it is for the function or mode of operation of a machine. In most cases in which a claim has been held to be functional, the inventor has claimed more than he invented, or at all events he claimed an exclusive right to do in any and every way something that other people had wanted to do before he did it. He asserted this right merely because he was the first person who had succeeded in doing it at all. The possibility and the desirability of using the power of the electric current to make intelligible signs at great distances had been recognized by many men before Morse found a method of doing it. Being the first inventor of that method he was entitled to the monopoly of it for the

> statutory period. Moreover, as a pioneer he was entitled to have his claims so construed as to cover the broadest possible range of equivalents."

The resulting decree of the said district court declared that (R., 182) "letters patent of the United States, No. 831,501, to Herbert M. Dickinson, dated September 18, 1906, for candy-pulling machines (being the patent in suit) are good and valid in law" as to claim 1 thereof, and to have been infringed (R., 183).

The Circuit Court of Appeals for the Fourth Circuit, on appeal to it from said decree of said District Court for the District of Maryland said (R., 185):

> "The reasoning of the district judge (Rose), by which he reaches the conclusion that the defendant's candy-pulling machine operating under the Henry patent is an infringement of the prior right of the complainant Hildreth as assignee under the first claim of the Dickinson patent, leaves nothing to be added. While strong argument against it has been submitted, we think it remains unbroken."

And the decree of the District Court for Maryland was accordingly affirmed.

In Hildreth *vs.* E. J. Smith Company (United States District Court, Southern District of Flor-

ida; not officially reported; see R., 188) similar contentions as to invalidity and inoperativeness were again urged and were again disposed of in your petitioner's favor, the learned District Judge Call saying (R., 188, 189):

> "The bill of complaint charges an infringement of claim 1 of the Dickinson patent, No. 831,501, issued in 1906.
>
> "The answer of the defendant denies the infringement and alleges that said claim 1 is void.
>
> "The testimony shows that the complainant is the owner of the Dickinson patent, and that said patent was duly issued by the Patent Office after a considerable contest before the Patent Office and before the Court of Appeals of the District of Columbia, and that claim 1 was sustained in all these proceedings; so that it may be assumed, without fear of successful contradiction, that said Dickinson patent is valid in this particular claim."

In the case at bar, answering the contentions of Mastoras that claim 1 of petitioner's patent in suit, by reason of the successive actions of the Patent Office in the above-mentioned interference proceedings had been rendered subject to a narrow rather than the broad construction which by settled law attends all pioneer inventions and basic patents covering same, District Judge Wolverton said (R., 18, 20):

"Originally Dickinson made but three claims, of which what is now claim 1 was the third, and the suggestion is based upon the fact that at one stage in the proceeding claims 1 and 2 were rejected by the examiner. However, further action was taken respecting the rejected claims, a matter which counsel seems to have overlooked, whereby claim 1 was eventually allowed in exactly the same language as first written. It now constitutes claim 10 in the patent. Claim 2 was also allowed, with an amendment to avoid a supposed conflict with Firchau, making it read 'a series of more than two pins or pulling members' instead of 'a series of pins or pulling members.' As amended, it is now claim 11. The Firchau concept was not in its operation a machine for pulling candy at all, but one for working or mixing candy. The contrivance consists of a drum with two pins or fingers extending therein, which are rotated in opposite directions, and has none of the elements of the Dickinson machine.

"This disposes of any interference of narrow construction that might otherwise have been drawn from the fact of the examiner first rejecting claims 1 and 2 as first propounded by Dickinson, and also of any contention that the Firchau patent anticipates the Dickinson device. These matters of conflict were settled in the Patent Office in the interference proceeding and need no further elucidation." * * *

"There is no dispute here involving priority of invention. There is a dispute,

however, which presents the question whether the complainant has any invention at all, or an invention presenting any utility or importance. This is predicated upon the insistence of one of counsel for the defendant that there is a total inoperativeness of the machine constructed under the Dickinson patent. That the device is inoperative, if such is the case, is provable under the general issue. Reckendorfer *vs.* Fabor, 92 U. S., 347, 354.

"Aside from the presumption that the patent affords that the Dickinson machine is operative, the testimony here satisfactorily shows it to be a fact. Complainant (R., 22), the present owner of the patent, had and still has one of the machines in his factory. He testifies that he has used it in practical operation, and that while, as originally constructed, it did not pull candy satisfactorily, yet by shortening the reach of the pull and speeding up the mechanical apparatus for moving the pins, it did the work all right, and would pull candy commercially. The change in construction to speed up the operation in no way affected the principle involved by the invention. A model has been introduced in evidence showing the mechanical operation of the machine, and it is within itself a demonstration that it pulls candy.

"Take any plastic, cohesive substance, held by two objects, separately adjusted, which are made to pass a stationary intervening object, one upon each side thereof, and the substance, when contract is made

with the intervening object will be caused to lap on itself and to stretch or be pulled as candy is pulled by hand. Again, when the positions of the two objects are reversed, in manner as the Dickinson device designs they shall be, one of the objects passes between the intervening or stationary object and the other of the two, and another contact with the substance is made, which will cause it to stretch or be pulled, but in a less degree, because the reach of the movement is shorter. Can there be any doubt about a device of the kind, and thus operated, stretching or pulling the substance mechanically? Surely there can be none. If none, what becomes of the alleged inoperativeness of the Dickinson device? By causing the two objects to move in opposite directions past the intervening or stationary object, and to be reversed at the respective extremeties, the substance will again be caused to be twice stretched or pulled, in the same way as above indicated, and thus will be completed a cycle in operation of the Dickinson device. The continued operation consists in repeating the cycles in movement of the moving objects in relation to the stationery object (R., 23). No further argument is necessary to convince one that the device is mechanically operative for pulling candy in some form. It may not be the best device possible for the purpose but it is self-evident that it will pull candy." * * *

"No better illustration in discussion can be produced than that which comes out of the interference proceeding in the

Patent Office. In the long struggle Dickinson had in the Patent Office by reason of the interference proceedings, which extended over a period of five years, five other applications for patents were at one time and other involved in the controversy. In some instances, the applicants withdrew the broad claims which were said to be in conflict with those of the other inventors, and accepted patents which covered merely the special types of machines designed by them. In other cases, the question of priority was, after more or less prolonged contest, determined by the Patent Office. The five were those of Hildreth, Jenner, Thibodeau, Robinson, and Henry. The one idea common to all these applications, including Dickinson's, is that couched in the exact language of claim 1 of the Dickinson patent as finally approved and issued by the Patent Office. That the claim was considered to contain the basic principle or elements dominating the claims of all the applicants is attested by the strenuous contest made upon the part of each applicant to have it read into his patent above that of the other contestants. *The Patent Office not only declared Dickinson to be the original* (*R.* 24) *and first inventor of the device embodying the principle, but further declared that the principle itself was basic in character and dominated all the other devices for which applications were then pending, or at some time had been during the interference proceedings.*" * * *

(R. 25.) "Now, the principle of pulling candy is common to all these machines. They all have the intersecting or in-and-out movement of the pins acting relatively to each other, by which the candy is engaged and lapped, and stretched or pulled. This is practically the only way that candy can be pulled commercially. The idea was suggested, no doubt, by the method of hand-pulling, by which the candy is thrown over a stationary hook and stretched. Then, by holding the end in one hand, the elongated hank is seized in the center, with the other, and the hank again thrown over the hook, and the pulling repeated.

"What was desired was a machine that would pull candy on the same principle. Dickinson first hit upon such a contrivance by resorting to the system of pins so disposed and so operated as to produce relatively the in-and-out movement, and thus to engage the candy, and lap or stretch or pull it. None of the other machines produced in the interference proceedings did more. Some of them, perhaps all of them, pulled candy more successfully, but they all resorted to the same principle for pulling candy as did Dickinson. The in-and-out or intervening movement of the pins operating relatively to each other was found common to all, and this whether the pins consisted of three or more than three, or whether they were (R. 26) vertically or horizontally disposed; and the question of needed support for the candy other than the pins afforded, while the machine was in operation, was treated as

wholly irrelevant to the controversy. *In the light of all this, the examiner of interferences defined the issue as relating to a pioneer invention and of a generic nature broad enough to include the widely different types of machines shown in the several applications.*" * * *

"The effect of these decisions is certainly sufficient to render the patent *prima facie* proof of the operativeness and utility of the Dickinson machine, whatever may be the rule generally. But being a pioneer patent, no one could expect the operative character of the device to respond to the highest test of perfection in the art. Judge Hough has stated the principle clearly in Engineer Co. *vs.* Hotel Astor et al., 226 Fed., 779, as follows:

"'A device need not be perfect in order to escape the charge of inoperativeness. * * * The test of operativeness is to ascertain whether the patented device does (even lamely and imperfectly) perform the acts claimed for it in the method described and (perhaps) for the reasons given.'

"The cases are numerous to the same purpose. See, among others, Telephone cases, 126 U. S., 536; Mergenthaler Linotype Co. *vs.* Press Pub. Co., 57 Fed., 502, 506; Thomson-Houston Electric Co. *vs.* Lorain Steel Co., 103 Fed., 641, 644; Crown Corke & Seal Co. *vs.* Aluminum Stopper Co., 108 Fed., 845 (R. 27).

"The claim that the Dickinson machine will stir candy, but will not pull it, and there-

fore that it is inoperative to pull candy is not sustained." * * *

"*The fact that the Dickinson patent is a pioneer in the art entitled it to a broad construction.* Of course, it could not be broader than the claim. But a reference to the claim shows it to be broad in character, *and to comprise any candy-pulling machine having a plurality of oppositely-disposed hooks or supports, a candy-puller and means for producing a relative in-and-out motion of the parts.*

"'If,' says the court, in Miller *vs.* Eagle Manufacturing Co., 151 U. S., 186, 207, 'the invention is broad or primary in its character, the range of equivalents will be correspondingly broad, under the liberal construction which the courts give to such inventions.'

"As we have seen, the principle sought to be applied is the relative in-and-out movement of the pins so as to bring the same in contact with the candy and cause it to be lapped and pulled. The principle is basic, and dominates all machines constructed for pulling candy which seek to apply it in operation.

"The defendant's machine has the relative in-and-out movement perfectly, and without it the machine would not pull candy. It is of a type, respecting the basic principle of its operation, not different from those machines considered in the interference proceeding. It is a marked improvement on the Dickinson machine, but it cannot be operated without applying the basic principle

for pulling candy by machinery which Dickinson invented; and this in itself is a demonstration that it infringes the Dickinson patent. That the defendant's machine has two stationary pins and one moving, as against two moving, and one stationary in the Dickinson and Robinson patents, makes no difference. The principle of the relatively intervening or in-and-out movement of the pins is applied in each, and that is the essential thing." * * *

"The principle is restated in Morley Machine Co. *vs.* Lancaster, 129 U. S., 273, as follows:

" 'Where an invention is one of a primary character, and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same result are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine.'

"See also Westinghouse *vs.* Bayden Power Brake Co., 170 U. S., 537, 569.

"Turning again to claim 1 of the Dickinson patent, its language and wording, it can be read directly upon the Langer patent, and while the mechanism is different in arrangement and in the movement of its parts, it performs the same service in substantially the same way, and the appliances adopted by the Langer patent are but mere mechanical equivalents of those used in the Dickinson machine. It results that the Langer

> patent infringes that of Dickinson as it respects claim 1 of the latter patent.
>
> "Nor is claim 1 functional merely, and therefore too broad to be sustained. The reasoning of Judge Rose, in Hildreth *vs.* Lauer & Suter Co., 208 Fed., 1005, 1012, to my mind satisfactorily disposes of the proposition, and I need not repeat it here."

From the foregoing statement and extracts from opinions in reported cases in which the validity of claim 1 of the patent in suit, its scope, and its basic character, and also the operativeness of the Dickinson machine as shown were repeatedly brought in question, it plainly and affirmatively appears that in each and every instance, save only in that of the Circuit Court of Appeals for the Ninth Circuit in the case at bar, said claim 1 was held—

(*a*) to be valid;

(*b*) to embody and protect a pioneer conception and invention;

(*c*) to be broad in scope and character and "to comprise any candy-pulling machine having a plurality of oppositely-disposed hooks or supports, a candy puller and means for producing a relative in-and-out motion of the parts" (R., 27), and

(*d*) The Dickinson machine as shown is operative.

Graphically stated five (5) executive officers, specially trained and peculiarly charged with the administration of the laws pertaining to the granting of patents, to wit:

(*a*) Examiner of Interferences (R., 125),

(*b*) The Board of Examiners-in-Chief (3 members) (R., 153), and

(*c*) The Commissioner of Patents (R., 157),

have in turn resolved all of said questions in favor of the patent in suit and of your petitioner, its owner and possessor.

Also that nine (9) United States judges, having the subject-matter and the precise questions under judicial consideration, to wit:

(*d*) Court of Appeals, D. C. (3 judges) (R., 163);

(*e*) United States District Court for the District of Maryland (Rose, D. J.) (R., 167);

(*f*) United States Circuit Court of Appeals for the Fourth Circuit (3 judges) (R., 185);

(*g*) United States District Court for the District of Oregon (Wolverton, D. J.) (R., 18);

(*h*) United States District Court for the Southern District of Florida (Call, D. J.) (R., 188),

likewise have resolved each and every of said questions in favor of the patent in suit and of your petitioner, its owner.

In addition to all of the above, since the rendition of the opinion by Wolverton, D. J., in the instant case, conclusions in accord therewith have been expressed by Tuttle, D. J., holding United States District Court for the Eastern District of Michigan, in the case of *Hildreth vs. A. J. Koerber*, which has not yet been reported.

In each of the above-mentioned opinions and in the executive or judicial action and orders based thereon, the use by the pioneer inventor Dickinson in his specifications of the descriptive phrase, "the candy is acted upon in a manner and by means of the shifting hook along a path corresponding to what I term a figure '8'," was held to be applicable and justified by the fact and it remained for the learned Circuit Court of Appeals, of all the tribunals that had to do with the subject-matter, to discover and to declare that "it is impossible, however, to find in the operation of the Dickinson machine a movement of candy in the course of a figure 8."

The fact that defendant Mastoras, by way of defense, set up and relied upon the very lately issued

letters patent 1,232,697 to Gotthold L. Langer, dated July 10, 1917 (R., 299), which letters patent were not referred to in the Lauer & Suter Company, the Fourth Circuit Court of Appeals case, is of no consequence, for as found and declared by the learned district judge (Wolverton, R., 27), the principle covered and protected by the Dickinson patent in suit "is the relative in-and-out movement of the pins so as to bring the same in contact with the candy and cause it to be lapped and pulled. The principle is basic and dominates all machines constructed for pulling candy which seek to apply it in operation."

And said learned district judge at the same time also declared:

> "The defendant's machine has the relative in-and-out movement perfectly, and without it the machine would not pull candy. It is of a type, respecting the basic principle of its operation, not different from those machines considered in the interference proceeding. It is a marked improvement on the Dickinson machine, but it cannot be operated without applying the basic principle for pulling candy by machinery which Dickinson invented; and this in itself is a demonstration that it infringes the Dickinson patent. That the defendant's (Mastoras) machine has two stationary pins and one moving, as against two moving and one stationary in the Dickinson and Robinson patents, makes no difference. The princi-

> ple of the relatively intervening or in-and-out movement of the pins is applied in each, and that is the essential thing."

These findings the learned Circuit Court of Appeals for the Ninth Circuit does not negative or even minimize. With reference to the "relative in-and-out movement of the pins," which the learned trial court, in concert with the executive officials and judges of the other courts which antedated him in action, held to be the dominant principle of the art of pulling candy by machinery, *i. e.*, to be "basic and dominates all machines constructed for pulling candy which seek to apply it in operation" (R., 27), the learned Circuit Court of Appeals for the Ninth Circuit said:

> "Both machines (*i. e.*, Dickinson's and Langer's) have means for producing a relative in-and-out motion of hooks. Dickinson's claim for a 'specified' relative in-and-out motion must be held to mean the in-and-out motion which is specified in the claims and specifications and exhibited by the machine itself. Dickinson acquired no monopoly of all in-and-out motions in candy" (R., 339).

The necessary effect of this pronouncement by the Circuit Court of Appeals for the Ninth Circuit, made in the case at bar, is to negative the basic and dominating character and status attributed by all of the other above-mentioned Federal courts and the specified executive officials, to petitioner's

(Dickinson's) letters patent 831,501 in suit, and to once again set at large the entire field of possible litigation which the previous decisions had supposedly foreclosed.

As further indicative of the importance and general character of the interest attaching to the correct and uniform decision of the questions involved in the instant and other pending suits, petitioner states that there are now pending and undecided the following cases, to wit:

Hildreth vs. The Schust Company, in the District Court of the United States for the Eastern District of Michigan, and

Hildreth vs. Bodison-Pierratt Company, in the District Court of the United States for the Northern District of Illinois,

in each of which cases questions as to the validity and scope of claim 1 of said letters patent No. 831,501, and also as to the operativeness of petitioner's Dickinson machine are at issue.

During the past several years by reason of the great commercial utility of said device and its general use in the art of candy making, attempts have been made and are continuing to be made by numerous infringers to benefit by the unauthorized use of various devices embodying the invention patented by claim 1 of petitioner's said letters patent here in suit.

Petitioner represents that if said erroneous decree of said Circuit Court of Appeals for the Ninth

Circuit be not here reviewed and reversed numerous intending and designing infringers will be encouraged to further ignore said claim 1 of petitioner's said letters patent 831,501, not only in the various States embraced within said ninth circuit, but in numerous other States of the United States embraced within judicial circuits other than the fourth circuit, and unless the now plainly divergent views and decisions of the Fourth and Ninth Circuit Courts of Appeals shall be reconciled without unnecessary delay, your petitioner's right in the premises will be seriously invaded, the benefits of his patent ownership will be reduced if not practically destroyed and the institution of many suits in the various district courts of the United States made necessary, all of which will be avoided by an authoritative and controlling expression of opinion by this honorable court in the premises.

In addition to the above-mentioned grounds of importance, general interest, and the diversity of view between the Circuit Courts of Appeals for the Fourth and the Ninth Circuits, this petition and the case referred to therein and sought to be reviewed thereunder presents for decision a fundamental proposition of law, of widespread general interest and concern in patent jurisprudence, that is, as to the degree of operativeness necessary in the showing of any patented device to support as valid letters patent of the United States purporting to cover the same.

This court said in the Telephone cases, 126 U. S., 1, at pp. 534 *et seq.*:

> "It is quite true that when Bell applied for his patent he had never actually transmitted telegraphically spoken words so that they could be distinctly heard and understood at the receiving end of his line. * * * The particular instrument which he had and which he used in his experiments did, not under the circumstances in which it was tried reproduce the words spoken so that they could be clearly understood; but the proof is abundant and of the most convincing character that other instruments, carefully constructed and made exactly in accordance with the specifications, without any additions whatever have operated and will operate successfully. * * * If one succeeds that is enough no matter how many others fail. * * * The law does not require that a discoverer or inventor in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practicable way of putting it into operation. This Bell did."

To like effect and of equal clarity is the expression of District Judge Hough in *Engineering Co. vs. Hotel Astor*, 226 Fed., 779, 783:

> "A device need not be perfect in order to escape the charge of inoperativeness. * * * The test of operativeness is to as-

> certain whether the patented device does (even lamely and imperfectly) perform the acts claimed for it in the method described and (perhaps) for the reasons given."

To like effect are:

Mergenthaler Linotype Co. vs. Press Publishing Co., 57 Fed., 502, 505.

Rogers Typograph Co. vs. Mergenthaler Lin. Co., 74 Fed., 799, 803.

Scott vs. Fisher, 145 Fed., 915.

Dalton Adding Mach. Co. vs. Rockford Milling M. Co., 250 Fed., 187.

Notwithstanding the above-quoted authoritative expression of this court, and the long list of reported cases based thereon, the Circuit Court of Appeals for the Ninth Circuit, in the instant case, discussing the question of operativeness and the necessity therefor, in petitioner's Dickinson machine, has declared its conception of the rule as follows (R., 337):

> "The fact that under a patent no machine has ever been made and shown to work successfully does not prevent the owner of the patent from restraining infringement. * * * But it is also true that if the patented device is not operative it cannot be infringed by one that is. * * * (Citing among other cases *Engineering Co. vs. Hotel Astor*, 226 Fed., 779, 783.) The case at bar is not one of those in which embodiment of a generic invention works imperfectly, but (and) in which the defects may be remedied by readjustment or relative

changes in size or shape or construction of members. It is not a case in which the invention as described is crude or defective, but is susceptible of improvement. If there is inoperativeness here, it is inherent in the very conception and structure of the device. *If it is not susceptible of use commercially, it has ~~no~~ utility, for it is obvious that such a machine can have no utility except in the commercial field.*"*

The declaration thus made by the Circuit Court of Appeals for the Ninth Circuit, viz., that to be validly patentable the device shown must be "susceptible of use commercially," constitutes an enlargement of or the engrafting of a new element upon the rule respecting operativeness formulated by this court.

Wherefore, in the interest of establishing uniformity of decision between the various United States Circuit Courts of Appeals, not only in the fourth and ninth circuits, but for other circuits likewise, and with a view of forestalling the litigation which will inevitably result from a refusal to review the decision of the Circuit Court of Appeals for the Ninth Circuit herein complained of, it is respectfully prayed that the writ of certiorari be issued herein, addressed to said Court of Appeals for the Ninth Circuit, requiring it to forwith transmit under its seal and the certificate of its clerk a full and duly certified transcript of all proceedings herein in order that upon review this honorable

* All italics supplied.

court may do what according to right and justice ought to be done.

Petitioner submits herewith a complete and duly certified transcript of the record of all proceedings had in the instant case in the Circuit Court of Appeals for the Ninth Circuit, including in full a copy of the opinion and decree of said court.

And petitioner will ever pray, etc., etc.

HERBERT L. HILDRETH,
By GEORGE P. DIKE,
FREDERIC D. McKENNEY,
His Attorneys.

To JIM M. MASTORAS, *Esquire*,
Portland, Oregon,
and
JOSEPH L. ATKINS, *Esquire*,
W. A. ROBBINS, *Esquire*,
DAVID E. LOFGREN, *Esquire*,
His Attorneys of Record:

Please take notice that on Monday, June 7, 1920, if submission of petition for certiorari be then allowed, and if not, then on the first motion day of the Supreme Court of the United States thereafter occurring, at 12 o'clock noon, or so soon thereafter as counsel may be heard, the foregoing and annexed petition for writ of certiorari will be submitted to said Supreme Court of the United States for its consideration and action.

GEORGE P. DIKE,
FREDERIC D. McKENNEY,
Attorneys for Petitioner.

FILED
DEC 4
JAMES D. BARKER
CLERK

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1920.

No. [redacted]51

HERBERT L. HILDRETH, PETITIONER,

v.

JIM M. MASTORAS, RESPONDENT.

MOTION ON BEHALF OF RESPONDENT TO ADVANCE CASE ON THE DOCKET.

JOSEPH L. ATKINS,
W. A. ROBBINS,
Attorneys for Respondent.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1920.

No. 333

HERBERT L. HILDRETH, PETITIONER,

v.

JIM M. MASTORAS, RESPONDENT.

MOTION ON BEHALF OF RESPONDENT TO ADVANCE CASE ON THE DOCKET.

Before the Honorable the Supreme Court of the United States:

Now comes the respondent, Jim M. Mastoras, by his attorneys of record, Joseph L. Atkins and W. A. Robbins, and moves this Honorable Court to advance this case on the docket.

This motion is made under provisions of the Rule of Court, No. 26 (6), and the special and peculiar circumstances required thereby to be shown to the Court are set forth in the following statement.

Each one of the two parties to this suit is the owner of letters patent of the United States; the

petitioner, Herbert L. Hildreth, being owner of letters patent No. 831,501, (R. 222) for candy pulling machine, hereinafter denominated petitioner's patent, issued on the 18th day of September, 1906, to petitioner, as assignee of the inventor, Herbert M. Dickinson; and the respondent, Jim M. Mastoras, being owner of letters patent No. 1,232,697, (R. 297) for candy pulling machine, hereinafter denominated respondent's patent, issued on July 10, 1917, to respondent, as assignee of the inventor, G. L. Langer.

Suit was brought in the District Court of the United States in and for the District of Oregon by said petitioner, to enjoin infringement of petitioner's patent, charged against said respondent by reason of manufacture and use by respondent of the machine described in respondent's patent.

Respondent denied the validity of the petitioner's patent, and denied infringement.

The issues were tried before the Honorable Charles E. Wolverton, District Judge, who having, in an opinion (R. 18), held petitioner's patent No. 831,501 to be valid as to claim 1 thereof, and to have been infringed by the defendant-respondent, granted, under date of September 21, 1918 (R. 30-31), an injunction against the respondent Mastoras.

Thereupon, said respondent took an appeal to the Circuit Court of Appeals for the Ninth Circuit. That Court, upon motion presented for the petitioner-appellant for leave to have cause heard

on typewritten transcript of record and upon showing presented to the Court, ordered motion granted (R. 331).

The cause was heard, and in an elaborate opinion filed February 24, 1920 (R. 333-342), the Court of Appeals reversed the decree of the Court below, stating the real grounds for its decision in the following language:

> "But aside from the question of the operativeness and utility of the Dickinson machine, we are of the opinion that the decree should be reversed for failure of the appellee *(petitioner)* to sustain the charge of infringement" (R. 338).

Decree accordingly was entered February 24, 1920 (R. 342).

Petition for rehearing was denied on April 5, 1920 (R. 343).

Order staying issuance of the mandate for a period of thirty days, under Rule 32, to allow petition for writ of certiorari, was made April 9, 1920 (R. 344).

Petition for certiorari was presented to this Honorable Court on June 7th., 1920, but, by reason of adjournment of the Court, went over to October 5th. of the next term when it was again presented and granted.

From the foregoing it appears that ever since September 21, 1918 (R. 31), respondent has been restrained by injunction from the exercise of all

rights under his patent. Already, at this time, more than two years of the life of said patent have fruitlessly expired. The life of petitioner's patent (R. 222), on the contrary, will expire in less than three years, and with it that monopoly in the candy pulling art that has been built upon that patent.

It is a significant fact to be considered in this case that said patent is, as petitioner asserts (petition for certiorari, p. 27) of great commercial value. It is estimated from evidence of record (R. 168) that the monoply under his patent yields to petitioner, at this time, a daily revenue of more than $1000.00. It is that monopoly which petitioner admits in his petition (p. 28) to be, if the decision rendered in this case by the Ninth Circuit Court of Appeals prevails, seriously menaced by respondent's patent.

That decision is that the respondent does not, by exercise of rights under his patent, infringe petitioner's patent.

Respondent's patent, moreover, describes that which the United States has solemnly recognized, by its grant, to be a distinct advance in the art.

The question of infringement involved in the present cause has never been litigated in any other. It is *sui generis*.

There is, indeed, not even necessary conflict between decisions in different circuits involved in the case now before this Court, since validity, within broad scope, may be conceded to petition-

er's patent without prejudice to respondent's denial of infringement.

Ample time for preparation of his case has already accrued to petitioner, and, for the reasons set forth, it is vital to respondent to know, with the least delay that may meet the convenience of this Honorable Court, what his just rights are in the premises. That portion of the life of respondent's patent which has already expired since respondent was placed under injunction, and which, pending decision of this Court, must still expire, is, by reason of the bearing of his patent upon petitioner's patent and the monopoly thereunder, the very soul of the life of respondent's patent.

Assuming the decision of the Court of Appeals to be good in law, every day's delay of a final decision in this case is not only a material extension beyond lawful bounds of a monopoly that is no longer entitled to subsist, but also is working irreparable injury to respondent.

Wherefore, upon consideration of right and justice, this motion is made on behalf of respondent.

Respectfully submitted,

JIM M. MASTORAS,
By JOSEPH L. ATKINS,
W. A. ROBBINS,
His Attorneys.

To HERBERT L. HILDRETH, *Esquire,*
Boston, Massachusetts,

and

GEORGE P. DIKE, *Esquire,*
FREDERIC D. MCKENNEY, *Esquire,*
His Attorneys of Record:

Please take notice that on Monday, December 6, 1920, or on the first motion day of the Supreme Court of the United States thereafter occurring, at 12 o'clock noon, or so soon thereafter as counsel may be heard, the foregoing motion and accompanying statement will be submitted to said Supreme Court of the United States for its consideration and action.

JOSEPH L. ATKINS,
W. A. ROBBINS,
Attorneys for Respondent.